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22852	7590	09/12/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			SHWAREGED, BETELHEM	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/823,920
Filing Date: April 14, 2004
Appellant(s): RANGWALLA, IMTIAZ

MAILED
SEP 12 2007
GROUP 1700

Mike McGurk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 06/11/2007 appealing from the Office action mailed 03/09/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0001108 A1	Rangwalla et al.	01/2003
5,382,282	Pennaz	01/1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13, 15-26 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangwalla et al. (US 2003/0001108 A1) in view of Pennaz (US 5,382,282).

Rangwalla discloses a packaging material comprising a substrate, a lacquer coating on the substrate, and an ink print layer between the substrate and the ink print layer, wherein the lacquer coating substantially identical to the claimed lacquer ([0097]-[0108]), and has a normalized thickness of 0.5-20 g/m² [0109]. The substrate is disclosed in [0112]. The lacquer is curable by particle beam machine [0110] and [0111]. Sandwiching the print layer and any intermediate layer between materials that are used for forming the substrate is well known in the packaging material art (see Example 8). The ink in the print layer can be electron beam curable [0116]. Rangwalla does not disclose the claimed ink composition.

Pennaz teaches an electron beam curable ink composition for printing, wherein the ink composition is disclosed in (col. 20, lines 1-43).

Rangwalla and Pennaz are analogous art because they are from the same field of endeavor that is the particle beam curable material art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ink composition of Pennaz with the invention of Rangwalla so as to provide a printed packaging material containing ink composition having enhanced water stability and viscosity (see col. 19, line 38 of Pennaz).

(10) Response to Argument

Claims 1-13, 15-26 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangwalla et al. (US 2003/0001108 A1) in view of Pennaz (US 5,382,282).

Applicant argued that the Examiner has failed to establish a *prima facie* case of obviousness, and has failed to identify a reason for combining the teaching of Rangwalla and Pennaz. These arguments are not persuasive for the following reasons. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rangwalla teaches a substrate and a lacquer substantially identical to the claimed substrate and lacquer, respectively. Rangwalla further teaches that an ink print layer provided between the substrate and the lacquer (see previous rejection). Even though Rangwalla does not teach the use of electron beam curable ink composition selected from acrylate esters, vinyl ethers, cycloaliphatic diepoxides, and polyols; Rangwalla teaches the use of electron beam curable ink composition. In addition, Pennaz teaches the use of electron beam curable ink composition selected from acrylate esters, vinyl ethers, glycol and compound listed in col. 20, lines 1-43). The ink composition of Pennaz is provided on a paper or other print substrate (col. 1, line 65 thru col. 2, line 3). The motivation for combining Rangwalla and Pennaz is the need for the use of electron beam curable ink composition to be applied on a layered material.

Applicant further argued that the Examiner has improperly shifted the burden of production to the Applicant by applying the doctrine of inherency to allege that which is missing from the claims. This argument is not persuasive for the following reasons. Neither Rangwalla nor Pennaz expressly discloses that the ink does not bond with lacquer, and both the ink and the lacquer are cured by the same method of curing, the

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ink eventually bonds with the lacquer. Furthermore, the claimed “---bonding to each other---” refers to any type of bonding or attachment. In Rangwalla the lacquer layer is applied over the ink layer, and there must be some kind of physical or chemical bonding or attachment to keep the layers together, otherwise the lacquer layer falls off.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Betelhem Shewareged


BETELHEM SHEWAREGED
PRIMARY EXAMINER

Conferees:


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